

## REMARKS

Applicant has studied the Office Action dated August 11, 2008. Claims 75, 91-94 and 99 have been amended and claims 90 and 95 canceled without prejudice. It is submitted that the amendments to the claims have support in the application as originally filed and, therefore, no new matter has been added.

Claims 63-67, 69-71 and 75-89, 91-94 and 96-99 are pending, with claims 63-67, 69-71, 80-89 and 98 having been previously withdrawn from consideration. Claims 63 and 75 are independent claims.

It is submitted that the application, as amended, is in condition for allowance. Reconsideration and reexamination are respectfully requested.

### Amendments to the Claims

Claims 91-94 and 95 have been amended to correct dependency in view of a canceled claim. It is respectfully submitted that the amendments have support in the application as originally filed and are not related to patentability.

### § 103 Rejections

Claims 75-79, 90-93, 96, 97 and 99 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hsu (U.S. Pat. No. 5,907,604). This rejection is respectfully traversed.

It is respectfully noted that the Federal Circuit has provided that an Examiner must establish a case of prima facie obviousness. Otherwise the rejection is incorrect and must be overturned. As the court recently stated in In re Rijkaert, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993):

"In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. 'A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill

in the art.' If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned." (citations omitted.)

With this paper, claim 90 has been canceled without prejudice. It is, therefore, respectfully submitted that the rejection is moot with respect to claim 90 and it is respectfully requested that the rejection be withdrawn.

#### Independent Claim 75

It is respectfully noted that independent claim 75 has been amended with this paper to incorporate the subject matter of claim 95, which has been canceled without prejudice. Therefore, independent claim 75, which now recites that the calling party or the receiving party can unilaterally change the selected format for transmitting the media information, will be discussed with respect to the rejection of claim 95.

It is respectfully noted that the Examiner, at paragraph 3 on page 4 of the Office Action, indicates that Hsu fails to disclose "the calling party or the receiving party can unilaterally change the selected format for transmitting the media information." It is further respectfully noted that the Examiner asserts, at paragraph 3 on page 5 of the Office Action, that Lev, et al. ("Lev" U.S. Pat. No. 5,987,327) discloses this limitation at c. 6, II. 4-32. Applicant respectfully disagrees with the Examiner's interpretation of Lev.

It is respectfully noted that the Examiner asserts that Lev discloses a "negotiated" information transfer." It is also respectfully noted that the Examiner further asserts that the disclosure in Lev would make it "obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Hsu by allowing the negotiation between the calling party and the called party ... and furthermore, the calling party would unilaterally [decide] on the minimum bandwidth requirement so as to complete the service."

It is respectfully submitted that, even if the Examiner's assertion with regard to Lev disclosing a "negotiated" information transfer between the calling party and the called party is arguably correct, such disclosure would not support the Examiner's assertion that "one of ordinary skill in the art at the time the invention was made" would be motivated "to modify the system of Hsu" such that "the calling party would unilaterally

[decide] on the minimum bandwidth requirement so as to complete the service" in the absence of any specific disclosure in Lev of an embodiment where there is a unilateral decision. Moreover, it is respectfully noted that the Examiner has not identified any portion of Lev that teaches a unilateral decision by either the "calling party" or the "called party."

It is respectfully submitted that "negotiation" is the exact opposite of a decision that is made "unilaterally." Therefore, it is further respectfully submitted that the Examiner's assertion with regard to "the calling party would unilaterally [decide] on the minimum bandwidth requirement so as to complete the service" is not supported, and therefore, Lev fails to cure the deficiencies of Hsu with regard to the calling party or the receiving party can unilaterally change the selected format for transmitting the media information, as recited in independent claim 75.

#### Dependent Claim 93

With regard to the rejection of claim 93, it is again respectfully noted, as was done previously, that the disclosure in Hsu is that "[v]ideophone 280 also receives composite video information from, e.g., external video cameras at 282" and that "[v]ideophone 280 transfers information to desktop PC 284, notebook PC 286 and personal digital assistant (PDA) 288." See Hsu at col. 4, ll. 57-61. It is again further respectfully noted, as was done in previous responses, that the disclosure in Hsu is that "[s]till camera 290 transfers picture information to the desktop PC, notebook PC and PDA." See Hsu at col. 4, ll. 61-63.

It is again respectfully submitted, as was done in previous responses, that the proper interpretation of the cited portion of Hsu is that the "videophone 280," "external video cameras at 282" and "still camera 290" in FIG. 4 of Hsu are located at the "calling party" and the "information" is transferred to a "desktop PC 284, notebook PC 286 and personal digital assistant (PDA) 288" that are located at the "receiving party." In support of the Applicant's submitted interpretation of Hsu, the Examiner's attention is again respectfully directed, as was done in previous responses, to the disclosure at col. 2, ll. 14-23 of Hsu that it is the "calling party" that defines the "image" that is "associated with their Caller ID" and it is the "calling party" that transmits the "image" to the "receiving

party" as well as to col. 5, ll. 13-55 of Hsu, which discloses that "the operations of image capture 350 ... are performed at the transmitting end ... performed by components at the sending, or calling, party's end." Moreover, it is again respectfully submitted, as was done in previous responses, that there is no disclosure in Hsu of any selection by the receiving party of any format for transmitting the media information, as recited in claim 93.

It is again respectfully noted, as was done in previous responses, that the Examiner, in the Response to Arguments at paragraph 1 on page 6 of the Final Office Action issued on February 6, 2008, asserted that the disclosure at col. 4, ll. 54-64 of Hsu that "[v]ideophone 280 also receives composite video from, e.g., external video camera" is analogous to the recitation in claim 99 that the calling party selects the at least one format for transmitting the media information and the disclosure that "[v]ideophone 280 transfers information to desktop PC 284, notebook PC 286 and personal digital assistant (PDA) 288" is analogous to the recitation in claim 93 that the receiving party selects the at least one format for transmitting the media information. Applicant again respectfully disagrees with the Examiner's asserted interpretation of the disclosure in Hsu.

It is respectfully noted that the Examiner, at page 3 of the present Office Action, essentially asserts the same portions of Hsu with respect to the rejection of claim 93. However, it is again respectfully submitted, as was done in previous responses, that the Examiner has not indicated any asserted analogies between the calling party and receiving party recited in claims 93 and 99 and the "videophone 280, "external video camera," "desktop PC 284," "notebook PC 286" and "personal digital assistant (PDA) 288" in the asserted portions of Hsu. It is again further respectfully submitted, as was done in previous responses, that the Examiner has not indicated how the disclosure in Hsu that the "videophone 280 also receives compost video" is analogous to the "videophone 280" or "external video camera" selects any format nor how the "[v]ideophone 280 transfers information" is analogous to the "videophone 280" or "desktop PC 284, notebook PC 286 and personal digital assistant (PDA) 288" selects any format.

It is again respectfully submitted, as was done in previous responses, that the only viable interpretation of Hsu is that “videophone 280,” “external video cameras at 282” and “still camera 290” in FIG. 4 of Hsu are located at the “calling party” and the “information” is transferred to a “desktop PC 284, notebook PC 286 and personal digital assistant (PDA) 288” that are located at the “receiving party.” Therefore, it is again further respectfully submitted, as was done in previous responses, that the only transmitting of media information between a calling party and a receiving party that is arguably disclosed in Hsu is of a “videophone 280” of a calling party transmitting media information to a “desktop PC 284, notebook PC 286 and personal digital assistant (PDA) 288” of a receiving party.

It is again respectfully submitted, as was done in previous responses, that the only portion of Hsu that arguably discloses which of the parties selects the format for transmitting information is at col. 2, ll. 14-23 and col. 5, ll. 13-55 and the disclosure at those portions of Hsu is explicitly that it is the “calling party” or the “transmitting end” that performs all the operations. It is again further respectfully asserted, as was done in previous responses, that there is no disclosure in Hsu that the “receiving party” has any effect on the selected format.

It is respectfully submitted that the Examiner has failed to address the present version of claim 93. It is respectfully noted that claim 93 recites that the receiving party unilaterally selects the at least one format for transmitting the media information. However, it is further respectfully noted that in addressing claim 93 in the present Office Action, the Examiner fails to acknowledge that Claim 93 now recites unilateral action by the receiving party.

The Examiner is respectfully invited to respond to the previous arguments in order that the Applicant may better understand the Examiner’s position. In the absence of such response, it is respectfully submitted that claim 93 contains allowable matter and is not anticipated by Hsu or the knowledge of one of ordinary skill in the art.

#### Dependent Claims 92 and 99

It is again respectfully noted, as was done in previous responses, that the present invention is directed to allowing the “communicating parties” to “control the

amount of information they want to transmit based on how much they are willing to pay for various communication services” and to allow “users to control the types of media services that they would like to receive, thereby allowing the users to control costs and the extent of media services to be received.” See specification at paragraphs 19 and 68.

It is again further respectfully noted, as was done in previous responses, that the present invention is directed to one embodiment where the receiving party may “designate one or more service options he or she would like to receive” in order to “control the type of media information to be received” and that the “user of the receiving terminal may enter into an agreement with the wireless carrier to ensure that only lower-bandwidth media is displayed” via a “controller at the switching station which blocks or otherwise filters out higher-bandwidth media” or “the receiving terminal may be configured to block display of higher-bandwidth media, even though it may have been sent by the transmitting terminal” or “the receiving terminal may be programmed to replace received media information with alternative media information stored in a terminal memory.” See specification at paragraphs 37-47. It is again respectfully submitted, as was done in previous responses, that claim 93 is directed to this embodiment.

It is respectfully noted that the Examiner, at page 4 of the present Office Action, indicates with regard to claim 92 that Hsu fails to disclose “an identification of the selected at least one format for transmitting the media information is stored in association with calling party identification information, and determined at the receiving party terminal.” It is further respectfully noted that the Examiner further asserts that “it would have been obvious that any chosen format of the calling party for transmitting the media information to the receiving party (col. 2, ln. 16-18) must be agreed in advance by both parties.”

It is again respectfully noted, as was done in previous responses, that the present invention is specifically directed to another embodiment where “the present invention controls the manner in which media information is displayed based on the person who sent the information.” See specification at paragraph 49. It is again respectfully submitted, as was done in previous responses that claim 99 is directed to

this embodiment. It is further respectfully noted that the Examiner, at page 3 of the present Office Action, merely asserts the same portions of Hsu previously cited with regard to the rejection of claim 99 without responding to any of the arguments previously presented.

It is again respectfully submitted, as was done in previous responses, that unlike the conventional system, the present invention is specifically directed to unilateral control of the format for transmitting the media information and, therefore, allows for the information that the calling party transmits not being received by the receiving party. The Examiner's attention is again respectfully directed, as was done in previous responses, to the present specification at paragraphs 73-74, which specifically discloses that "the transmitting terminal may transmit continuous video output from the camera unit in the terminal" but the "receiving terminal may capture and then display the video, and in the meantime may store the script" so that "the receiving terminal may display this script repeatedly ... without requiring any additional allocation of network resources."

Applicant respectfully submits that the Examiner has not addressed the present version of claims 92 and 99 and that the "obvious" result of the Examiner's asserted modification of Hsu would not anticipate the present invention as recited in claims 92 and 99. It is respectfully noted that the present claims 92 and 99 recite that the receiving party (claim 92) or the calling party (claim 99) unilaterally selects the at least one format for transmitting the media information.

It is respectfully noted that the Examiner, In addressing both claims 92 and 99 in the present Office Action, fails to acknowledge that those claims now recite unilateral action by either the calling party or receiving party. It is respectfully submitted that the Examiner's opinion of what would be "obvious" suffers from the same deficiencies previously addressed with regard to the Examiner's interpretation of Lev in rejecting claims 94 and 95 in that what would be an "obvious" modification of Hsu is a "negotiated" action as opposed to a unilateral action, as evidenced by the Examiner's statement that "any chosen format of the calling party for transmitting the media information to the receiving party ... must be agreed in advance by both parties" since "agreed" implies negotiation that would preclude unilateral action as recited In claims 92

and 99. Therefore, it is respectfully submitted that claims 92 and 99 contain allowable matter and are not anticipated by Hsu or the knowledge of one of ordinary skill in the art.

It is respectfully asserted that independent claim 75 is in condition for allowance. It is further respectfully asserted that claims 92, 93 and 99 also are allowable over the cited reference by virtue of the limitations recited therein as well as by virtue of their dependence from allowable claim 75. Moreover, it is respectfully submitted that claims 78, 79, 96, and 97 also are allowable over the cited reference at least by virtue of their dependence from allowable claim 75.

Claims 94 and 95 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hsu, in view of Lev et al. ("Lev" U.S. Pat. No. 5,987,327). This rejection is respectfully traversed.

With this paper, claim 95 has been canceled without prejudice. It is, therefore, respectfully submitted that the rejection is moot with respect to claim 95 and it is respectfully requested that the rejection be withdrawn.

As previously respectfully asserted, independent claim 75 is allowable over the combination of Hsu and Lev. It is further respectfully asserted that claim 94 also is allowable over the cited combination of references at least by virtue of its dependence from allowable claim 75.

## CONCLUSION

In view of the above remarks, Applicant submits that claims 75-79, 89-94, 96, 97 and 99 of the present application are in condition for allowance. Reexamination and reconsideration of the application, as originally filed, are requested.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California telephone number (213) 623-2221 to discuss the steps necessary for placing the application in condition for allowance.

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